

REMARKS

Based on the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has rejected claims 4-5 and 11 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Yamashita. Applicants respectfully disagree with this rejection.

Yamashita only discloses, in Fig. 6, a compact rising liquid treatment device 31 comprising transport means 33, a catch trough 32, a feed line 9, an outflow 8, a pump unit 5 and a filter unit 18. Yamashita fails to disclose any modular expansion module modular assembly with a “separate transportable conventional wet suction device (7) . . . only one suction opening (8) “to a rinsing liquid treatment device (2).” Yamashita discloses two necessary openings (each for feed line 9 and for outflow 8) of the catch trough 32 of the rising liquid treatment device 31. Contrary to the Examiner’s opinion (p.3, l.1-3), the device disclosed by Yamashita is not capable of being used as a modular expansion module because there is not any common (necessary bidirectional for feed line and outflow)

interface to a separate transportable conventional wet suction device (7) . . . only one suction opening (8).

This difference is important since compact rising liquid treatment is well known in the art; see DE3545328 cited in the application. The object of the invention, thus, is to divide the device into two parts whereby one part is a separate transportable conventional wet suction device (7) containing a transport means (5) and only one suction opening (8) and the other part is the “modular expansion module . . . comprising a pump unit (13) and at least one of a filter unit (14) and a cooling unit (15) in the flow circuit.”

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See

also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since Yamashita fails to disclose each and every feature of independent claim 4, Yamashita, as a matter of law, does not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that Yamashita does not anticipate or make obvious the present invention as defined in claim 4, and the present invention is patentable over such reference. Claims 5 and 11 depend on claim 4 and are allowable for the same reasons claim 4 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 1 are not disclosed or suggested in the prior art.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying

on *Ex Parte Levengood*, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that those teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

In view of the above, it is respectfully submitted that Yamashita does not make the present invention, as defined in Claim 4, obvious, and the present invention is patentable over such reference.

Claims 5 and 11 depend on Claim 4 and are allowable for the same reasons Claim 4 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in

order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



Ronit Gillon
Reg. No. 39,202

Dated: June 14, 2005
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7354

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313-1450 on June 14, 2005.

